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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/391,869	09/08/1999	MARY SMITH	83317/00004	9219

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EXAMINER

HENDERSON, MARK T

ART UNIT PAPER NUMBER

3722

DATE MAILED: 12/23/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/391,869

Applicant(s)

SMITH, MARY

Examiner

Mark T Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-25 and 32-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 and 32-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Attachment I

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## **DETAILED ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

### ***Response to Arguments***

1. In view of the Appeal Brief filed on October 6, 2003, PROSECUTION IS HEREBY REOPENED. For purposes of clarity, a new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

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(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 35 is rejected under 35 U.S.C. 102(b) as being anticipated by Michlin (5,141,252).

Michlin discloses in Fig. 1-3, a pocket insert capable of passing through a printer (Col. 3, lines 15-18) comprising a base sheet (16) with a thickness and a binding edge (folded area located at binding staple, 12) a pocket sheet (17) having the same thickness as that of the base sheet (Col.

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2, lines 40-46), an adhesive or securing means between the base sheet and the pocket sheet to form a pocket with an opening (C) facing the binding edge; and wherein the pocket insert has a maximum thickness equal to the combined thickness of the single thickness (of the base sheet), the single sheet thickness (of the pocket sheet) and the adhesive.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-9, 11-13, 16-18, 22, 23, and 25-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wyant (5,823,573) in view of Dick.

Wyant discloses in Fig. 1, a book (not shown) having a pocket insert comprising: a base sheet (22) made of paper material having a binding edge (14a, located on the left side of insert (5), near apertures (30)), wherein the base sheet (22) has a planar first surface (A1), a planar second surface (A2), a width (W2) defined by a first edge (14a) and second edge (14b), and a length (L1) defined by a third edge (14c) and fourth edge (14d) ; a pocket sheet (11) having a

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planar inner surface (11a), a planar outer surface (11b), a perimeter defined by a first attached edge section (11c, 11e, 11f) and a second free edge section (11d), wherein at least a portion (11c and 11e) of the attached edge section (11c, 11e, 11f) is bonded by any suitable means to the base sheet (22); and the free edge section (11d) being unattached to the base sheet to form a pocket opening (B); a third edge (11c) and a fourth edge section (11c) defining the pocket sheet length (L2); and wherein the pocket sheet has a width (W1) smaller than a width (W2) of the base sheet (22); and wherein the base sheet (22) and the pocket sheet (11) are arranged such that the pocket opening (B) faces and extends parallel to the binding or binding edge (14a); wherein the base sheet (22) and pocket sheet (11) are formed of a single section of paper material and folded along a fold line (15).

However, Wyant does not disclose: a pocket sheet perimeter defined by an attached edge section on the inner surface, wherein the section is attached through bonding, fusion or glueing to the first surface along a plurality of seams; and wherein the pocket has a width at least 60 percent of the width of the base sheet; wherein the pocket sheet and base sheet are separate sheets; wherein the base sheet and pocket sheet are adhered along respective edges; wherein the base sheet and pocket sheet are formed of a rectangular sheet having particular sizes; and a front and back cover, wherein the pocket inserts are bound between the covers, and further wherein the pocket retain supplemental media.

Dick discloses in Fig. 1-4, a pocket insert at a particular location comprising a pocket sheet (4) perimeter defined by an attached edge section on the inner surface to a base sheet (1) by

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through any securing means along a plurality of seams (5), wherein the pocket sheet and base sheet are separate sheets (seen in Fig. 2); and wherein a front and back cover are used to bind the inserts together, and wherein the pockets are used to retain supplemental media (8).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Wyant's pocket insert to include a separate pocket sheet attached to a base sheet to form a pocket insert, wherein the sheets are attached by any securing means and wherein the inserts retain supplemental media and are bound between two covers as taught by Dick for the purpose of providing a more secured pocket.

In regards to **Claims 4, 16-18, , 25, 32, 33**, it would have been an obvious matter of design choice to construct the pocket sheet and base in any desirable dimensions (length, width, and thickness), since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Note, it is further understood that since applicant has broadly claimed an attachment method, it is well known that the types of methods of attaching (or securing by: gluing bonding or fusing) are considered an alternative (or suitable) securing method as evidenced by looking at Class 412-Bookbinding.

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4. Claims 10, 14, 15, 19-21, 24 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wyant in view of Dick and further in view of Ruebens (4,965,948).

Wyant as modified by Dick discloses a pocket insert comprising all the elements as claimed in Claims 1, 6, 7, 9, 13, 22, and 23, and as set forth above. However, Wyant and Dick do not disclose wherein the pocket sheet and base sheet are further adhered to one another along a strip, or a portion of the inner surface, so as to separate into two pockets.

Reubens discloses in Fig. 1, 3-6, a pocket sheet (22) that is adhered to a base sheet (20) along a strip or inner portion (26) which separates the pocket sheet into two pockets.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Wyant and Dick's pocket insert to include an adhesive strip as taught by Reubens for the purpose of defining a plurality of pockets to hold numerous articles.

#### ***Response to Arguments***

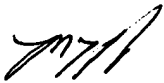
5. Applicant's arguments with respect to claims 1-36 have been considered but are moot in view of the new ground(s) of rejection.



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**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

December 22, 2003



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